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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/300,671	04/27/1999	HIROKAZU TAKAGAKI	450100-4862	4747

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EXAMINER

TRINH, SONNY

ART UNIT PAPER NUMBER

2681

DATE MAILED: 03/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/300,671

Applicant(s)

TAKAGAKI, HIROKAZU

Examiner

Sonny TRINH

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 January 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 7-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### **1. CONTINUED EXAMINATION UNDER 37 CFR 1.114 AFTER FINAL REJECTION**

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 01/07/03 has been entered.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 7-18 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 7-8, 10-11, 13-14, 16-17** are rejected under 35 U.S.C. 103(a) as being unpatentable over Jackson ("Jackson"; Patent No. 6,516,466), Wegrzyn (Wegrzyn;

Patent No. 5,729,540) and in further view of Salomaki, Ari (Salomaki; International Publication Number WO 97/28649).

Consider **claim 7**. With reference to figures 1, 4a, 5 and their detailed descriptions, Jackson teaches a mobile communication apparatus (figures 4a-5), comprising:

a) communication means for transmitting and receiving information signals to and from a base station (figure 5, element 54 for communicating with base station 12, 14 of figure 1) via radio waves (microwave cellular transmitter/receiver 54) between cellular network 12 and user terminal 18, 20 of figure 1); said base station further transmitting and receiving information signals to and from a service provider through a public line network (figure 1, columns 1-2, specifically lines 30-59 of column 1, since the music and games are stored in the mass storage unit and provided to user(s) upon request(s), it is inherent that these services are run by a service provider);

b) input/output means for a user to interact with said mobile communication apparatus (figures 3,5,7); said input/output means comprising a keypad, display means (column 4, specifically lines 53-67, "the user can view the display window and make a selection"), a speaker (inherent so that the user can listen to the music), and a microphone (column 3, specifically line 62);

However, Jackson does not disclose that the communication apparatus is operable to receive said information signals from said base station automatically and periodically.

In an analogous art, Wegrzyn teaches the system and method for scheduling messages on a common channel. Wegrzyn further teaches communication apparatus is operable to receive said information signals from said base station automatically and periodically (column 3, lines 23-45). However, the combination of Jackson and Wegrzyn does not disclose the memory means including a removable semiconductor memory and the processing means for encrypting the information signals prior to storage in said memory means.

In an another analogous art, Salomaki teaches the scrambling of digital media objects in connection with transmission and storage. Salomaki further teaches that Smart Card can be used in products like GSM mobile telephone system that can encrypt the data in connection with transmission and storage so that their reception and reproduction without a permission is as difficult as possible (page 2, specifically lines 4-15, page 4, specifically lines 17-34). Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to include, within the Jackson's system, the periodically and automatically downloading data, as taught by Wegrzyn, and the removable memory module and encryption technique, as taught by Salomaki in order to download data whenever the traffic is light so as not to overburden the network as taught in the cited paragraph in Wegrzyn's and by encrypting the data in connection with transmission and storage in the Smart Card, as taught by Salomaki, the user can protect his/her personal information that are stored in the memory module.

Consider **claim 8**. Jackson further teaches the communication apparatus comprising recording/reproducing means for recording information signals input to said

memory means and for reproducing information signals stored in said memory means (column 3 line 54 to column 4 line 13 "the song can be recorded to memory for later playback).

Consider **claim 10**. The combination of Jackson, Wegrzyn and Salomaki together discloses the invention, however, the combination does not disclose a headphone device so that a user can listen to the information (it is noted that Jackson teaches the portable cellular stereo similar to the "Walkman" type player in column 1 and this type of player usually including a headset). However, using a headphone is widely known and used in the communication field and the Examiner takes Official notice of such use for protecting the privacy of the information (i.e. music, voice) that is being presented to the user or when the user simply does not want to be bother by any other noise source or does not want to bother anybody else.

Consider **claim 11**. Jackson further teaches the information signals include music data (column 1, lines 60-67, column 3 line 54 to column 4 line 13) while Wegrzyn discloses the voice data (CDMA telephone (column 4 lines 48-67).

4. **Claims 9, 15** are rejected under 35 U.S.C. 103(a) as being unpatentable over Jackson ("Jackson"; Patent No. 6,516,466), Wegrzyn (Wegrzyn; Patent No. 5,729,540), Salomaki, Ari (Salomaki; International Publication Number WO 97/28649) and in further view of Kariya (Kariya; Patent No. 6,169,897).

Consider **claim 9**. The combination of Jackson, Wegrzyn and Salomaki together discloses the invention, however, the combination does not disclose that said public line network is the internet and said base station communicates with said service provider

using a universal resource locator. In another analogous art, Kariya discloses a mobile communications system which provides a mobile subscriber with local information. Kariya further discloses that said public line network is the internet and said base station communicates with said service provider using a universal resource locator (figures 1-2, detailed description, column 3, line 54 to column 5, line 32).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to include, within the Jackson's system, the periodically and automatically downloading data, as taught by Wegrzyn, and the removable memory module as taught by Salomaki, and the internet with the URL, as taught by Kariya in order to tap into the vast information afforded by the internet for downloading different types of data.

5. **Claims 12, 18** are rejected under 35 U.S.C. 103(a) as being unpatentable over Jackson ("Jackson"; Patent No. 6,516,466), Wegrzyn (Wegrzyn; Patent No. 5,729,540), Salomaki, Ari (Salomaki; International Publication Number WO 97/28649) and in further view of Bowen (Bowen; Patent No. 6,052,606).

Consider **claim 12**. The combination of Jackson, Wegrzyn and Salomaki discloses the invention, however, the combination does not disclose that display means comprises a liquid crystal display (LCD) having a touch sensing screen, whereby the user can input information signals by touching said touch sensing screen. In another analogous art, Bowen discloses a cellular telephone handset with a liquid crystal display screen including a touch sensitive functions using said LCD (figure 2, touch sensitive display 17, columns 1-2). Therefore, it would have been obvious to one of ordinary skill

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in the art, at the time the invention was made to include, within the Jackson's system, the periodically and automatically downloading data, as taught by Wegrzyn, and the removable memory module as taught by Salomaki, and the touch sensitive LCD, as taught by Bowen in order to enable a larger amount of information to be displayed simultaneously with the function keys on the screen.

As to **claims 13-18**, these claims merely reflect the method claim to the apparatus claim of claims 7-12 (respectively) and are therefore rejected for the same reasons.

### ***Conclusion***

***Any response to this action should be mailed to:***

*Commissioner of Patents and Trademarks  
Washington, D.C. 20231*

***or faxed to:***

*(703) 872-9314, (for formal communications intended for entry, for informal or draft communications, please label "PROPOSED" or "DRAFT")*

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, 6<sup>th</sup> Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sonny Trinh whose telephone number is (703) 305-1961. The examiner can normally be reached Monday through Thursdays from 7:00 am to 4:00 p.m., and on alternate Fridays.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 306-0377.



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*Sonny Trinh S.T.*

PATENT EXAMINER  
3/4/03

*Tracy Legree*  
TRACY LEGREE  
PRIMARY EXAMINER